

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. Claims 2-29 are pending. In this Reply, claim 1 has been canceled without prejudice or disclaimer. Claims 20-29 have been added. Claims 16, 17, and 20 are independent claims.

**Prior Art Rejection**

Claims 1-19 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Pavley et al.* (U.S. Patent 6,317,141) in view of *Hasegawa et al.* (U.S. Patent 6,084,169).<sup>1</sup> This rejection, insofar as it pertains to the presently-pending claims, is respectfully traversed.

Initially, Applicant notes that originally-presented independent claim 1 has been canceled in favor of newly-added independent claim 20. Independent claim 20 is directed to a digital camera, comprising: an image playback module for playing back a plurality of images accompanied by music prepared separately from the plurality of images in a first playback time; a music playback module for playing back the music in a second playback time; and an editing module for making a period of the first playback time substantially coincide with a period of the second playback time, the editing module defining the first playback time based on the

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<sup>1</sup> Although the introduction to this rejection set forth on page 2 of the Office Action refers only to claims 3-5 and 8, it is Applicant's

number of the images and on a playback time for each of the plurality of images, when sequentially playing back the plurality of images.

Thus, according to claim 20, the music for playback is prepared separately from the plurality of images, and an editing module of the digital camera makes a period of a first playback time, for playback of a plurality of images, substantially coincide with a period of the second playback time, for the music prepared separately from the images. In this manner, the claimed digital camera allows a user to flexibly match a period between the first playback time for the plurality of images and the second playback time for the music prepared separately from the plurality of images. Thus, the digital camera as claimed can more effectively display a plurality of images along with the accompanying music.

The primary reference, *Pavley*, discloses a digital video camera that captures various types of image data, including video and still images. Col. 3, lines 55-61. Audio is recorded by an audio sub-system 142 along with video data. Col. 5, lines 37-67. Although the digital video camera of *Pavley* allows a user to edit media objects to be played back (see e.g., col. 12, lines 34-43), *Pavley* fails to disclose or suggest an editing module as recited in claim 20, which, for separately prepared music and a plurality of

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understanding from the remainder of the Office Action that all originally presented claims, 1-19, are subject to this rejection.

images, makes a period of a first playback time for playback of the plurality of images substantially coincide with a period of a second playback time for the separately prepared music based on the number of images and a playback time for each of the plurality of images.

The secondary reference, *Hasegawa*, discloses a technique for composing background music for an input image. See e.g., col. 1, lines 8-15. More specifically, *Hasegawa* discloses:

In a background music assigning method according to this invention, a given moving or changing image is divided into scenes, a feature of each scene is extracted, the feature is converted into a parameter to be used for automatic musical performance, background music is automatically composed by using the parameter and scene reproduction time, and background matching an atmosphere and reproduction time of the moving or changing image is outputted, together with the moving or changing image. (Col. 1, line 62 - col. 2, line 3).

Applicant submits, however, that *Hasegawa* fails to teach or suggest the editing module as recited in independent claim 21.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that

claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

In view of the above, the asserted combination of *Pavley* and *Hasegawa* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 20, or any claim depending therefrom. Furthermore, independent claims 16 and 17 (as well as their dependent claims) define over the asserted combination of *Pavley* and *Hasegawa* based on similar reasoning to that set forth above with regard to claim 20.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below,

to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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